REMARKS

Claims 1-112 were pending and presented for examination in this application. In an Office Action dated March 22, 2007, claims 1-112 were rejected. Applicants address the Examiner's comments below. Applicants are amending claims 1 and 78 in this Amendment and Response. These changes do not introduce new matter, and their entry is respectfully requested. In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding objections and rejections, and withdraw them.

Response to Rejection Under 35 USC 103(a)

Claims 1, 15-16, 35, 47, 50, 65, 78, 92-93, and 112 are rejected under 35 USC 103(a) as allegedly being unpatentable over U.S. Patent No. 5,884,056 to Steele in view of U.S. Patent No. 5,633,723 to Sugiyama. This rejection is now traversed.

Representative claim 1, as amended, recites:

> A multifunction printer for printing time-based media, the multifunction printer comprising:
>
> a communication interface for receiving time-based media data from a media source;
>
> a processor embedded within the multifunction printer for performing a multimedia function on the time-based media data to automatically identify a portion of the time-based media data to be automatically printed to a tangible medium, the identified portion corresponding to criteria received from a user;
>
> a user interface, communicatively coupled to the processor, including:
>
> a display, for providing data to the user;
>
> an input device, for receiving a selection of the multimedia function from a plurality of selectable multimedia functions and for receiving the criteria from the user;

a first output device for receiving the identified portion of the time-based media data from the processor and automatically printing the identified portion; and

a second output device coupled to the processor for receiving the identified portion of the time-based media and producing an electronic output including the identified portion of the time-based media.

Claim 78, as amended, recites a method that includes similar claim elements. The claimed invention includes a multifunction printer that allows a user to select from among a plurality of multimedia functions to be performed on time-based media using a processor embedded within the multifunction printer. Examples of functions that can be performed are illustrated in FIG. 4 and FIG. 5. A user selects a multimedia function to be performed that identifies a portion of the time-based media to be printed to a tangible medium. The identified portion is outputted in an electronic format and is automatically printed by the multifunction printer.

Neither Steele nor Sugiyama are directed to a multifunction printer and both references fail to disclose or suggest the claimed elements of "an input device for receiving *a selection of the multimedia function from a plurality of multimedia functions.*" Furthermore, both references fail to disclose or suggest a user-selected multimedia function to "identify a portion of the time-based media data *to be automatically printed to a tangible medium.*"

Steele is not directed to a printer. Rather, Steele discloses a system for video browsing on the World Wide Web, and is directed at solving the "problem of providing video data in a manner which best utilizes the available throughput to provide video data in a form which is most useful to the user" (col. 2, lines 62-65). A user is provided

with thumbnails of a video image. By selecting a pair of the thumbnails, a new set of thumbnails is generated, each of the new thumbnails taken from a portion of the video temporally between the chosen pair. This allows the user to narrow the time frame of thumbnails being looked at, in order to locate a particular portion of the video. (See, e.g., col. 3, line 57 to col. 4, line 21.)

The Examiner suggests that Steele discloses receiving a user selection of a multimedia function in column 6, lines 13-18. However, in the cited text Steele merely discloses a user selecting a video object. Although a function is performed on the video object (generating thumbnails for display), the user does not select the function *from a plurality of selectable multimedia functions*.

Sugiyama does not remedy this shortcoming of Steele, and does not disclose or suggest the missing feature. Sugiyama discloses a video printer that allows frames of a video to be deleted and replaced with "white mute data." Sugiyama's video printer is not a multifunction printer and does not receive a selection of a multimedia function from a plurality of selectable multimedia functions from the user. Sugiyama discloses several keys (FIG. 1, reference numerals 21-25) that allow the user to facilitate memory operations (store, delete, or print) but the keys do not select any multimedia function to be performed on the time-based media.

Both references also fail to disclose that the multimedia function *identifies a portion of the time-based media data to be automatically printed to a tangible medium*. Sugiyama discloses that in order to print an image, the user selects a memory key 21 to freeze a displayed image and then initiates printing with a print key 23. (col. 4, lines 45-54). Thus, the portions of the time-based media to be printed are identified

by the user and are not identified by a multimedia function. Steele does not disclose or suggest printing at all, and instead merely discloses outputting video frames to a display.

Thus, the deficient disclosures of these references, considered either alone or in the combination suggested by the Examiner, thus fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. § 103(a) can be made. A *prima facie* showing of obviousness requires (1) some suggestion or motivation to modify the reference, (2) a reasonable expectation of success, and (3) that the reference(s) teach or suggest all the claim limitations. As discussed above, the references do not teach or suggest all of the claimed limitations. Thus, Applicants submit that claims 1 and 78 are patentably distinguishable over the cited references.

Furthermore, it would not have been obvious to print the video frames in Steele as the Examiner suggests. Steele displays video "thumbnails" for the purpose of providing navigation links to zero in on a desired portion of the video data. Printing the thumbnails of Steele would provide no obvious benefit to a user of Steele because the printed copies could not provide any use in navigation of the video. Therefore, in contrast to the Examiner's remarks, it would not be obvious to modify Steele to include an output device for printing a portion of time-based media identified by a multimedia function.

As claims 15-16, 35, 47, 50, 65, 78, 92-93 and 112 depend from claim 1 or 78, all arguments advanced above with respect to claim 1 and 78 also apply to claims 15-16, 35, 47, 50, 65, 78, 92-93 and 112. Thus, Applicants respectfully assert that claims

15-16, 35, 47, 50, 65, 78, 92-93 and 112 are also patentable over Steele and Sugiyama, both alone and in combination for at least the reasons recited above.

In the 4th-20th paragraphs of the Office Action, the remaining dependent claims have further been rejected under U.S.C. 103(a) as allegedly being unpatentable over Steele and Ishikawa in various combinations with U.S. Patent No. 6,118,888 to Chino; U.S. Patent No. 5,091,948 to Kametani; U.S. Patent Application Publication No. 2002/0101513 A1 to Halverson; U.S. Patent No. 6,611,622 B1 to Krumm; U.S. Patent No. 6,594,377 B1 To Kim; U.S. Patent No. 5,568,406 to Gerber; U.S. Patent Application Publication 2003/0220988 A1 to Hymel; U.S. Patent Application Publication No. 2002/0010641 A1 to Stevens; U.S. Patent No. 6,296,693 B1 to McCarthy; U.S. Patent No. 5,115,967 to Wedekind; U.S. Patent Application Publication No. 2001/0003846 A1 to Rowe; and U.S. Patent No. 6,373,498 B1 to Abgrall.

The cited references each fail to disclose or suggest all of the claimed limitations previously discussed. For example, none of the above cited references disclose or suggest a multifunction printer having "an input device for receiving *a selection of the multimedia function from a plurality of multimedia functions,*" or a user-selected multimedia function to "identify a portion of the time-based media data *to be automatically printed to a tangible medium.*" Furthermore, the dependent claims recite additional elements that also are patentably distinguishable from all cited combinations of the above references. Therefore, Applicants respectfully request that the Examiner reconsider the rejections to the remaining dependent claims and withdraw them.

Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them. In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully submitted,
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